REMARKS/ARGUMENTS

The rejections presented in the Office Action dated February 1, 2006 (hereinafter Office Action) have been considered. Claims 1-50 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 1-8, 10-38, 40-42 and 44-50 stand rejected under 35 U.S.C. §103(a) as being unpatentable over "Publish Dynamic Applications on the Web" by D. McClanahan (hereinafter *McClanahan*) in view of "Using XML to Develop Applications for WAP and WWW Environments" by M. Honkala (hereinafter *Honkala*). Applicants respectfully traverse the rejection.

According to MPEP §2142, to establish a prima facie case of obviousness under 35 U.S.C. §103:

1) there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

2) there must be a reasonable expectation of success; and

3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

All three criteria must be met to establish *prima facie* obviousness of a claim. The Applicant respectfully submits that the combination of *McClanahan* and *Honkala* does not teach or suggest all of the limitations of Claims 1-8, 10-38, 40-42 and 44-50. In particular, regarding at least independent Claims 1, 34, 46-49, the combination of *McClanahan* and *Honkala* fails to teach or suggest embedding an application server address of one of a plurality of applications servers into provisioning information, nor does the combination teach or suggest provisioning a mobile terminal to facilitate access to the network application.

McClanahan describes conventional, server-side, Common Gateway Interface scripting that may be invoked using a browser. The Applicant first notes that the Examiner has not shown where *McClanahan* teaches or suggests embedding an application server

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address of one of the plurality of applications servers, wherein the application server provides access to a network application that is hosted by a plurality of application servers. The language used on pages 2-3 of the Office Action consistently refers to "a network application," "an application," "the server address," etc., and nowhere is it alleged that *McClanahan* teaches or suggests a network application that is hosted by a plurality of application servers, wherein one address of one of the plurality of applications servers is embedded in provisioning data. Further, the Applicant submits that *McClanahan* does not teach or suggest this feature of Applicant's Claims 1, 34, and 46-49. The Examiner did not rely on *Honkala* to remedy this deficiency of *McClanahan* , nor does *Honkala* provide such a remedy. For at least this reason, the combination of *McClanahan* and *Honkala* does not teach or suggest all of the limitations of independent Claims 1, 34, and 46-49, and a *prima facie* case of obviousness has not been established with respect to these claims.

Additionally, the Applicants respectfully disagree that *McClanahan* teaches provisioning of a mobile terminal. According to page 2, paragraph 3 of the Office Action *McClanahan* discloses "embedding a hypertext link into a web page or a button into a [sic] electronic form...the web page or form being 'provisioning' information provided to the user by a web server in a three-tier client-server architecture (i.e. sending the web page to the user of a browser for execution thereon over a network)." The Applicants respectfully disagree that the "web page or form" described in *McClanahan* is "provisioning" information as alleged in the Office Action.

In the recent case of *Phillips v. AWH Corp.*, the Federal Circuit held that the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, USPQ2d 1321 (Fed. Cir. 2005). As is known in the mobile communications art, and as described in Applicant's Specification (*see, e.g.*, p. 4, lines 10-14), provisioning relates to data used to configure a terminal, thereby enabling the terminal to use a service on a network. However, a "web page or form," by itself, is merely rendered for display by a browser, and web pages do not configure the underlying execution environment. According to the *McClanahan* reference, "HTML is not a programming language," (p. 2, Database and

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Programmatic Functionality), thus the characterization in the Office Action of the browser "executing" a web page is incorrect. The web pages and forms described in *McClanahan* are documents formatted in a markup language for purposes of display to the end user, and not for provisioning of a terminal.

Nonetheless, according to the Office Action, the terminal is provisioned "by enabling the user to invoke an application upon selecting said hypertext link." Applicants respectfully disagree that presenting a hyperlink to a user for selection can reasonably be construed as "provisioning" a terminal. It would be understood by one of ordinary skill in the art that a browser operating in this manner is already provisioned to use the service (e.g., HTTP) needed to access the content located at a valid URL. Thus, the Applicant respectfully submits that the interpretation applied by the Examiner to independent Claims 1, 34, and 45-49, as they relate to the term "provisioning," is unreasonably broad, and therefore the combination of references including *McClanahan* fails to establish *prima facie* obviousness.

The Examiner did not rely on *Honkala* as providing a remedy to the deficiencies of *McClanahan* as it pertains to provisioning features of independent Claims 1, 34, and 46-49, nor does *Honkala* provide such a remedy. Thus, because neither *McClanahan* nor *Honkala* teach at least the recitations of Claims 1, 34, and 45-49, a combination of *McClanahan* and *Honkala* fails to teach these recitations. The combination of *McClanahan* and *Honkala* fails to suggest the invention set forth in Claim 1, 34, and 45-49 as there is no reference to embedding an application server address of one of a plurality of applications servers into provisioning information, nor does the combination teach or suggest provisioning a mobile terminal to facilitate access to the network application. While other requisites of establishing prima facie obviousness may also be absent, the Applicants respectfully submit that the cited combination of references at least fails to teach or suggest all of the claim limitations. For at least this reason, Claims 1, 34, and 46-49 are not rendered obvious by the combination of *McClanahan* and *Honkala*, and withdrawal of the rejection is respectfully solicited.

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Regarding the rejection of Claims 2-5, 6-8, and 28-30, the Applicants first note that a plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group. M.P.E.P. § 707.07(d). The Examiner has rejected Claims 2-5, 6-8, and 28-30 based on the combination of *McClanahan* and *Honkala*, without addressing all of the limitations of individual Claims 2, 3, 4, 5, 6, 7, 8, 28, 29, and 30. Each of these claims recites different aspects of the invention, and it is unclear from the common rejection which items of the Examiner's listing are purportedly applicable to particular ones of the Claims 2, 3, 4, 5, 6, 7, 8, 28, 29, and 30. If the Examiner maintains the rejection, the Applicants request clarification on which parts of the rejection are being applied to each of these claims.

Further regarding the rejections of Claims 6-8, the Examiner has combined additional disclosure from *Honkala* in the rejection of Claims 6-8 without providing evidence of motivation to combine. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). For this additional reason, the Applicant respectfully submits a *prima facie* case of obviousness has not been established regarding Claims 6-8.

Further regarding the rejections of Claims 28-30, the Examiner has taken Official Notice that "communication associated with bootstrap process via which an application identifier and the associated application parameters upon initial configuration of the terminal...was old and well known in the art." (Office Action, pp. 6-7). The Applicant respectfully asserts that neither 1) a bootstrap provisioning process which provides the application identifier and the associated application access parameters upon initial configuration of the mobile terminal, 2) a re-provisioning process which provides the application identifier and the associated application access parameters subsequent to a bootstrap provisioning process, nor 3) a provisioning procedure effected in connection with provisioning the mobile terminal for one or more of a new service and an upgraded service, constitute facts outside of the record which are capable of instant and unquestionable

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demonstration as being well-known in the art. The numerous references relied on in the Office Action, for example, fail to disclose this purportedly "well known" fact. Applicants contend that reasonable doubt exists regarding the circumstances justifying the Examiner's exercise of Official Notice, and request that the Examiner provide evidence that demonstrates the appropriateness of the officially noticed facts pursuant to MPEP § 2144.03. Applicants reserve the opportunity to respond to the Examiner's comments concerning any such judicially noticed facts.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Taking Official Notice of the supposedly "old and well known" features disregards the requirement of analyzing Applicant's claimed subject matter as a whole. Applicant respectfully reiterates the legal tenet that facts so noticed should not comprise the principle evidence upon which a rejection is based. MPEP § 2144.03. Thus Applicants respectfully submit that Claims 28-30 are allowable over the references relied upon in the Office Action.

In addition to the above remark, Applicant notes that dependent Claims 2-8 and 10-33 depend from independent Claim 1; dependent Claims 35-38, 40-42, and 44-45 depend from independent Claim 34; and dependent Claim 50 depends from independent Claim 49. These dependent claims also stand rejected under 35 U.S.C. §103(a) as being anticipated by *McClanahan* in view of *Honkala*. While Applicant does not acquiesce with the particular rejections to these dependent claims, including any assertions concerning inherency or the taking of Official Notice, these rejections are now moot in view of the remarks made in connection with independent Claims 1, 34, and 49. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from *McClanahan* and *Honkala*. Therefore, dependent Claims 2-8, 10-33, 35-38, 40-42, 44, 45, and 50 are also in condition for allowance.

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Claims 9 and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *McClanahan* in view of *Honkala* in further view of Mobile Security by Malte Borcherding (hereinafter "*Borcherding*"). Applicants respectfully traverse the rejection.

For the rejections of Claims 9 and 43, the Examiner relies on *McClanahan* and *Honkala* as teaching the substance of the claims from which Claims 9 and 43 are dependent, namely, Claims 8 and 42 which are dependent from independent Claims 1 and 34. The Examiner does not rely on *Borcherding* as providing a remedy to the deficiencies of *McClanahan* and *Honkala* as it pertains to independent Claims 1 and 34, nor does *Borcherding* provide such a remedy. Thus, because neither *McClanahan*, *Honkala* nor *Borcherding* teach at least the recitations of Claims 1 and 34, a combination of *McClanahan*, *Honkala* and *Borcherding* fails to teach these recitations. Further, a combination of *McClanahan*, *Honkala* and *Borcherding* fails to suggest the invention set forth in Claims 1 and 34, as there is no reference to at least embedding an application server address of one of a plurality of applications servers into provisioning information, nor does the combination teach or suggest provisioning a mobile terminal to facilitate access to the network application. Nor does such a combination teach or suggest provisioning a mobile terminal to facilitate access to the network application. While other requisites of establishing *prima facie* obviousness may also be absent, the Applicants respectfully submit that the cited combination of references at least fails to teach or suggest all of the claim limitations. For at least this reason, Claims 9 and 43 are not rendered obvious by the combination of *McClanahan*, *Honkala* and *Borcherding*, and withdrawal of the rejection is respectfully solicited.

Claim 39 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *McClanahan* in view of *Honkala* in further view of "WAP Push OTA Protocol" by Mario Cannataro and Domenico Pascuzzi (hereinafter "*WAP Push*"). Applicants respectfully traverse the rejection.

For the rejections of Claim 39, the Examiner relies on *McClanahan* and *Honkala* as teaching the substance of the claims from which Claim 39 is dependent, namely, Claim 37 which is dependent from independent Claim 34. The Examiner does not rely on *WAP Push*
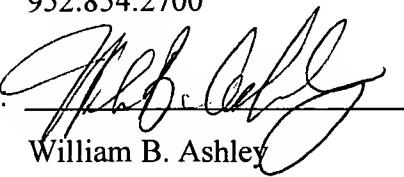
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as providing a remedy to the deficiencies of *McClanahan* and *Honkala* as it pertains to independent Claim 34, nor does *WAP Push* provide such a remedy. Thus, because neither *McClanahan*, *Honkala* nor *WAP Push* teach at least the recitations of Claim 34, a combination of *McClanahan*, *Honkala* and *WAP Push* fails to teach these recitations. Further, a combination of *McClanahan*, *Honkala* and *WAP Push* fails to suggest the invention set forth in Claim 34, as there is no reference to at least embedding an application server address of one of a plurality of applications servers into provisioning information, nor does the combination teach or suggest provisioning a mobile terminal to facilitate access to the network application. Nor does such a combination teach or suggest provisioning a mobile terminal to facilitate access to the network application. While other requisites of establishing *prima facie* obviousness may also be absent, the Applicants respectfully submit that the cited combination of references at least fails to teach or suggest all of the claim limitations. For at least this reason, Claim 39 is not rendered obvious by the combination of *McClanahan*, *Honkala* and *WAP Push*, and withdrawal of the rejection is respectfully solicited.

Authorization is given to charge Deposit Account No. 50-3581 (NOKM.017PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned agent of record invites the Examiner to contact him at to discuss any issues related to this case.

Respectfully submitted,

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